

### **REMARKS/ARGUMENTS**

Preliminarily, as a matter of clarifying the record, it is not clear whether claims 3-7, 9-11, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over EP 0335013 ("Kenbeek '013") as evidenced by GB 1390439 ("Marchand"), and as evidenced by Croda Product Overview ("Overview"). Applicants note that while claim 15 is listed in the paragraph section #9 heading on page 10 of the present Official Action, claims 3-7, 9-11, and 21 are highlighted on pages 10-14 (within the same section #9). Accordingly, this is presumed to be a typographical error.

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 5, 15, 19, and 21 have been amended. New claims 22-23 have been added. Support for the amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

Amendments to claim 15 render the objection to claim 15 moot.

Claims 3-7, 9-10, 15, 19, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,462,001 ("Kenbeek '001"). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001 in view of U.S. Patent 4,479,883 ("Shaub '883"), or in the alternative over Kenbeek '001 in view of U.S. Patent 4,293,432 ("Papay") and U.S. Patent 4,783,274 ("Jokinen"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '001 in view of U.S. Patent 3,202,701 ("Young"). Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, and as evidenced by Overview. Claims 10-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, as evidenced by Overview, and in further view of U.S. Patent 4,459,223 ("Shaub '223"). Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, as evidenced by Overview, and in further view of Kenbeek '001. Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek '013, as evidenced by Marchand, as evidenced by Overview, and in further view of Young.

Applicants submit that the pending claims are directed towards a method of reducing wear in an automotive engine by using an automotive engine oil having a specified ester, which is the reaction product comprising *inter alia*, (a) at least one polyfunctional alcohol, (b) a dimer fatty acid having a dimer content of greater than 94% by weight, and (c) at least one of an aliphatic dicarboxylic acid having 5 to 18 carbon atoms and an aliphatic monocarboxylic acid having 5 to 24 carbon atoms, wherein the ester has a kinematic viscosity at 100 °C ranging from 1100 to 5000 mm<sup>2</sup>/s.

In contrast, Kenbeek '001 does not teach or suggest the method of the pending claims for reducing wear in an automotive engine nor the specified ester used in said claimed method. For example, unlike the ester of the pending claims, the ester discussed in Kenbeek '001 requires a kinematic viscosity at 100 °C ranging from 30 to 1000 cSt (*i.e.*, mm<sup>2</sup>/s) (*see* Kenbeek '001 at col. 3, lines 8-10).

Similarly, Applicants note that Kenbeek '013 requires the ester to be derived from a dimeric fatty acid, a glycol, and a *C<sub>3</sub>-C<sub>12</sub> monoalcohol chain stopper* (*see* Kenbeek '013 at page 2, lines 40-42). Accordingly, Kenbeek '013 neither teaches nor suggests the ester of the pending claims, comprising, *inter alia*, (c) at least one of an aliphatic dicarboxylic acid having 5 to 18 carbon atoms and an aliphatic monocarboxylic acid having 5 to 24 carbon atoms. Consequently, Kenbeek '013 also cannot teach or suggest that the resultant ester of the pending claims, having a kinematic viscosity at 100 °C ranging from 1100 to 5000 mm<sup>2</sup>/s.

As none of the cited references, alone or in combination with the other cited references, cure the above-noted deficiencies of either Kenbeek '001 or Kenbeek '013, the pending claims are believed to be patentable over the cited references.

Therefore, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

JONES DAY

By: 

Paul L. Sharer  
Registration No. 36,004  
Direct No. (202) 879-5481

Intellectual Property Group  
51 Louisiana Avenue, N.W.  
Washington, D.C. 20001-2113  
(202) 879-3939 Telephone  
(202) 626-1700 Facsimile

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